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10/028,309	12/28/2001	Steven Holliday	52493.000145	2885

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EXAMINER
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NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3689

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10/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/028,309	<b>Applicant(s)</b> HOLLIDAY ET AL.	
	<b>Examiner</b> Tan Dean D. Nguyen	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

The Amendment filed 6/30/08 has been entered. Independent claims 1, 7, 10, 43 and 49 have been amended. Claims 1-53 are pending and are rejected as followed.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-53 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The term “a delivery solutions processor or module” as shown in Figs. 2, element 100
3. Claims 1-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The new limitation “a delivery solutions processor or module” as shown in Figs. 2, element 100, pages 4-5, are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. What are the names of the processor or modules or what programs they consist of?

***Response to Arguments***

4. Applicant's arguments filed 6/30/08 have been fully considered but they are not persuasive. Applicant's comments on pages 3-5 that the specification are properly described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention are not persuasive because applicant has not cited an example of how it works, specific functional software used to deliver a solution, etc. Applicant's arguments are merely applicant's opinion.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-6, and 10-42 (method) are rejected under 35 U.S.C. 101 because in order for a method to be considered a "process" under §101, a claimed process must either:

(1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials). See

*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 1-6 and 10-42 the claim language does not include the required (1) tie or (2) transformation, and thus is directed to nonstatutory subject matter. The current claim, step (a)-(c ) calls for “via a delivery processor or module” is not acceptable since it indicates an option of using the module which could be used and this module or reads over a software module which is not a statutory class. Deletion of “or module” in all the claims are recommended in order to overcome the rejections.

7. Claims 7-9, 43-48 and 49-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Note: that it appears that independent claims 7, 43 and 49 are an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987). Current claims comprise the term “a delivery processor or module” and dashboard (software) are not acceptable since it indicates an option of using the module which could be used and this module

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reads over a software module which is not a statutory class. Deletion of “or module” in all the claims are recommended in order to overcome the rejections.

***Claim Rejections - 35 USC § 112***

8. Claims 1-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claims 1-53, it's not clear what happens to the first developed item, “developed strategy” of step (a). All of the steps (b) –(e) using the second developed item or the “developed plan”.

2) In claims 1-53, the term “B2B”, “B2P”, “B2C”, etc. are vague and indefinite. They are not conventional/standard terms and could change with time, place, and environment. Applicant's comment that these term are supported in the specification and are commonly understood by one of ordinary skill are not persuasive for the reason set forth above.

3) Independent claims 1, 7, 10, 43 and 49 recite the limitation “new business” in step (e). There is insufficient antecedent basis for this limitation in the claim. Furthermore, there are 3 established relationships (b), (c) and (d). The claim calls for from at least 2 established relationships (plural). It's not clear whether the new business is created from at least 2 relationships like (b) and (c ) or (c) and (d) or all three relationships (b), (c ) and (d)? Furthermore, it's not clear how the “new business” is created from each of the steps (b)-(d) above?

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***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**11. Claims 1-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**(1) ADLER in view of (2) MORGAN et al or vice versa and further in view of (3)**

**MARPE et al.**

As of 6/30/08, claim 1 is as followed:

1. (Amended) A process for evaluating a business entity's success in developing new business, comprising the steps of:

a) developing a strategy and a plan to support at least one of the business entity's high level objectives in a component of the business entity, wherein the strategy and plan are developed via a delivery solutions processor or module;

(b) establishing a relationship between the component of the business entity and an agent or broker using the developed plan, wherein the relationship between the

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component of the business entity and the agent or broker is established via a B2B dashboard associated with the delivery solutions processor or module;

(c) establishing a relationship between the component of the business entity and a producer using the developed plan, wherein the relationship between the component of the business entity and the producer is established via a B2P dashboard associated with the delivery solutions processor or module; wherein the B2P dashboard further measures timeliness, a yield and cost of enabling a B2P relationship;

(d) establishing a relationship between the component of the business entity and a consumer using the developed plan, wherein the relationship between the component of the business entity and the consumer is established via a B2C dashboard associated with the delivery solutions processor or module; and

(e) processing new business resulting from the established relationships, wherein the new business is monitored via a new business dashboard associated with the delivery solutions processor or module.

Note: In claim 1, step (a), the phrase “to support ...business entity” is not a positively recited method step but, rather, is mere intended use of the accessed data and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

Also the phrase “are developed” or “is established” and “is monitored” are not a positive method step or positive limitation and is interpreted as “being capable of”. Similarly, the term “enable” in new amended limitation merely means “to allow” someone to carry out an activity and not doing the activity itself.



Note that it appears that this is a computer-implemented method or “data processing”, limitations such as “business entity” “broker” or “consumer”, etc., they are considered as non-functional descriptive material (NFDM) on the data of “business entity” or “broker”, thus having no patentable weight. The mere insertion of “broker” or “consumer” over “data” does not “impart functionality when employed as a computer component”, thus having no patentable weight. See MPEP 2106.01 “Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Similarly, **ADLER** fairly teaches a process for evaluating a business entity objective in developing new business (merger and acquisition), comprising the steps of:

(a) developing a strategy and a plan to support at least one of the business entity's high level objectives in a component of the business entity {see [0002], [0004], [0107]};

(b) establishing a relationship between the modified business entity and an intermediary or “middlemen” using the developed plan {see [0019], [0021]};

(c) establishing a relationship between the modified business entity and a producer using the developed plan {see [0025]};

(d) establishing a relationship between the modified business entity and a consumer using the developed plan {see Fig. 5, 5A, Fig. 9}; and

(e) processing new business resulting from the established relationships {see Fig. 1A, 15, [0002], [0006]}.

Note that ADLER teaches the analysis of the strategic business decisions for different scenarios such as merger and acquisition of business entities. Note that the terms such as “agent or broker” or “intermediary” or “producer” is considered as “non-functional descriptive material” and has no patentable weight. It merely represents a second entity with a function of “producing something” or serving as “agent or broker”. However, the functions are not positively claimed and thus the term has no patentable weight. Moreover, as shown on [0019], ADLER indicates that “intermediary” and “agent” or “broker” are basically the same or interchangeable or read over each other since they act like a “third party” between the “business entity” and the “customer/consumer”, based on how the business is carried out such as on-line (B2B) or off-line (conventional or manually). Also, from the “Background of the invention”, it appears that “intermediary” serves the same function as “agents or broker” or reads over “agent” or “broker”. Therefore, ADLER fairly teaches the claimed invention except for explicitly teaches the carrying out steps (b)-(e) using a component or business unit of the business entity.

In a similar business environment for analyzing business decision (achieve business objectives) for various business scenarios, i.e. trends, forecast, benchmark, site comparison, configuration changes, problem resolution, {see col. 4, lines 1-27, Fig. 1, 50}, **MORGAN et al** fairly teaches the establishing various relations between the most basic functions of an organization/entity (component of a business entity or business unit) and well known business entities, i.e. intermediary, producer, and customer for determining/evaluating the business strategies and obtaining business results (cost) and wherein the strategy and plan are developed via processor or module {see Figs. 1, elements 12, 30, 18, Figs. 3, 5, 6 “Business Unit/org” (84) and 7, col. 5, lines 5-67, Table B on col. 9}. It would have been obvious to modify the teachings of ADLER to include the evaluation of a business unit, most basic function of an organization, as taught by MORGAN et al to inherently obtain more accurate evaluation.

Alternatively, MORGAN et al fairly teaches the claimed invention except for the relationship between the component of the business entity and the entity wherein the component is acquired by the business entity. The teaching of ADLER is cited above. It would have been obvious to modify the teachings of MORGAN et al by carrying out scenario of which the component is acquired by the business entity such as merger and acquisition as taught by ADLER above.

The teachings of ADLER and MORGAN et al teaches the claimed invention except for failing to teach the use of monitoring dashboard in functions in (b)-(e).

In a similar business environment for managing new business project (merger and acquisition), MARPE et al discloses the use of Dashboard, i.e. Executive

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Dashboard, associated with the current network system for providing interested parties a single checkpoint to understand (tracking and monitoring) the current state of the project or access key information in a quick and illustrated manner {see Figs. 9, 10, cols. 17-19}. It would have been obvious to modify the teachings of ADLER /MORGAN et al by using the monitoring dashboard associated with the current network system as taught by MARPE et al for providing interested parties a single checkpoint to understand (tracking and monitoring) the current state of the project or access key information in a quick and illustrated manner {see Figs. 9, 10, cols. 17-19}.

**As for dep. claim 2** (part of 1 above), which deals with the type of the component of the business entity, a 2<sup>nd</sup> business acquired by the 1<sup>st</sup> business, this is taught in ADLER [0002], [0008]}.

**As for dep. claims 3-4** (part of 1 above), which deals with well known parameters in establishing relationship with a consumer, i.e. targeting, establishing contact, and selling a product to the consumer, these are non-essential to the scope of the claimed invention and would have been obvious to a skilled artisan to include these well known steps for conducting business with a consumer, as taught by MORGAN et al on cols. 17-19.

**As for dep. claims 5-6** (part of 1 above), which deals with business evaluating parameters, i.e. to access the success (promising strategy) using at least a well known business parameters/metrics, i.e. cost, timeliness, these are fairly taught in ADLER Fig. 1, (15), Fig. 1A (12) "Economic" or MORGAN et al Figs. 3-6.

**As for independent system claim 7**, which is basically the system to carry out the method of claim 1 above, it's rejected over the system of ADLER/MORGAN et al or vice versa/MARPE et al used for the rejection of method claim 1 above.

**As for dep. claims 8-9** (part of 7 above), which have the same limitations as in dep. claims 6, 3 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 6 and 3 above.

**As for independent method<sup>2</sup> claim 10**, which has the limitation of claims 1 and 3, it's rejected for the same reasons set forth in the combination of the rejections of claims 1 and 3 above.

**As for dep. claims 11-42**, (part of 10 above), which are merely well known parameters for business analyzing and implementing various business relationships, it would have been obvious to use these well known business parameters to carry out the specific steps (a)-(d) as mere using well known business parameters or analysis. These are fairly taught in MORGAN et al Figs. 1, 7, 8, Tables B, cols. 17-19.

**As for independent system<sup>2</sup> claim 43**, which is basically the system to carry out the independent method of claim 10 above, it's rejected over the system of ADLER/MORGAN et al or vice versa/MARPE et al used for the rejection of method claim 10 above.

**As for dep. claims 44-48** (part of 43 above), which have the same limitations as in dep. claims 2-6 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 2-6 above.

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**As for independent system<sup>3</sup> claim 49**, which is basically the system to carry out the independent method of claim 10 above, it's rejected over the system of ADLER/MORGAN et al or vice versa/MARPE et al used for the rejection of method claim 10 above.

**As for dep. claims 50-53** (part of 49 above), which have the same limitations as in dep. claims 2-6 (part of 1 above), they are rejected for the same reasons set forth in the rejections of dep. claims 2-6 above.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-53 have been considered but are moot in view of the new ground(s) of rejection and interpretation as indicated above. As for the new amended language as shown in step (d), this carries no patentable weight for the reasons set forth above.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 2003/0097319 by Moldovan teaches method for determining business solution.

2) US 2002/0082882 by Perry et al, discloses a computerized method for evaluating and shaping business proposal.

3) US 2001/0034628, by Eder, discloses a detailed method and system for modeling and analyzing business improvement programs.

4) US 7,107,224 by Weller et al, discloses a value driven integrated build-to-buy decision analysis system and method.

5)US 2003/0249657 by Kol et al, teaches synergism realization for enterprise change.

No claims are allowed.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689